

**REMARKS**

This paper is in response to the final official action of January 2, 2009, wherein (a) claims 10-12 were pending, (b) claim 10 was objected to on formal grounds, (c) claim 12 was rejected as being directed to non-statutory subject matter under 35 U.S.C. § 101, and (d) claims 10-12 were rejected under 35 USC 103(a) as obvious over Tilles et al. US 6,748,295 ("Tilles") in view of Weiser WO 02/29731 ("Weiser") and further in view of Reed et al. US 2002/0095454 A1 ("Reed").

Applicants respectfully traverse the rejections and request that they be withdrawn.

Entry and consideration of the amendment to claim 10 is solicited, as the amendment could not have been made earlier as the particular objection to claim 10 was presented for the first time in the most recent action and entering the amendment will narrow the issues on appeal.

**Claim Objections**

Applicants respectfully submit that the objection to claim 10 is overcome by the amendment to claim 10 presented herein. Applicants request withdrawal of the objection to claim 10.

**35 U.S.C. § 101 Rejection**

Applicants respectfully traverse the rejection of claim 12 as directed to non-statutory subject matter. Applicants respectfully submit that the Patent Office failed to establish a prima facie case of non-statutory subject matter. The Patent Office must "reach a conclusion as to whether it is more likely than not that the claimed invention as a whole either falls outside one of the enumerated statutory classes or within one of the exceptions to statutory subject matter." Emphasis added, M.P.E.P.

§ 2106(IV)(D). “The examiner bears the initial burden . . . of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Applicants respectfully submit that claim 12, as a whole, clearly defines statutory subject matter. In particular, claim 12 defines statutory subject matter properly classified as a machine. Claim 12 recites a device for transmission of notifications to users of an electronic parcel compartment system comprising, in part, a receiving device on which notification information is displayed and a communication interface that is an SMS gateway. While the official action correctly points out that claim 12 recites a database, a central sending component, a communication interface, an external interface, and a storage module, the official cannot ignore the remaining limitations recited in claim 12. The official action fails to consider claim 12 as a whole, as required by the M.P.E.P. A receiving device on which information is displayed is clearly statutory subject matter. Moreover, an SMS gateway necessarily comprises the computer hardware required to communicate an SMS message. For these reasons, Applicants respectfully submit that claim 12 is properly directed to statutory subject matter and Applicants respectfully request withdrawal of the rejection of claim 12.

### **35 U.S.C. § 103 Rejections**

Applicants respectfully traverse the rejection of claims 10-12 as obvious over Tilles in view of Weiser and Reed.

Claim 10 is directed to a method for the transmission of notifications to users of an electronic parcel compartment system within a postal shipping system, wherein information for creating notification jobs depends on events within an electronic parcel compartment system.

Similarly, claim 12 recites a device for the transmissions of notifications to users of an electronic parcel compartment system within a postal shipping system, wherein notification requests are based on an event in the electronic parcel compartment system.

As conceded in the official action, both Tilles and Weiser fail to disclose or suggest categorizing events within an electronic parcel compartment system into classes. See the official action at page 6. Rather, the official action relies on Reed as disclosing a categorization of events. However, Reed does not disclose or suggest categorizing events at an electronic parcel compartment system. In fact, Reed does not disclose or suggest an electronic parcel compartment system of any sort.

The official action fails to even allege that Reed categorizes events in a parcel compartment system, and thus the official action fails to establish a prima facie case of obviousness. The allegation that “Reed catagoriz[es] the events in classes” is not sufficient to show that Reed teaches categorizing events in an electronic parcel compartment system. In fact, Reed simply teaches that the “event 116 class is an abstract class defining the attributes for scheduled events 117 and logged events 118.” See Reed paragraph [0140]. This generic recitation of scheduled and logged events is not sufficient to show a teaching of categorizing events in an electronic parcel compartment system into classes, as recited by the pending claims. For this reason alone, the official action fails to establish a prima facie case of obviousness and Applicants respectfully request withdrawal of the rejection of claims 10-12.

Moreover, one of ordinary skill in the art would not modify Tilles and Weiser to include the event categorization of Reed because Reed is non-analogous art with

respect to claims 10-12. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor, or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

Reed fails the first prong of the analogous art test as Reed is not in the field of Applicants' endeavor. The field of Applicants' endeavor is shipping logistic systems, particularly electronic parcel compartment systems. See the instant application, page 3, lines 10-15. Reed, however, is in the field of automated communication systems. See Reed abstract. Thus, the fields of endeavor between the Applicants' invention and Reed are different. As a result, Reed fails the first prong of the test for analogous art.

With respect to the second prong of the test, the cited art must be reasonably pertinent to the problem with which the inventor was concerned. Reed fails this prong as well. The problem with which the applicants were concerned was providing users of an electronic parcel compartment system with a high degree of flexibility. See the instant application, page 2, lines 23-26. Reed is concerned with coordinating the transfer of data, metadata, and instructions between databases in order to control and process communications. See Reed, paragraph [0003]. As a result, Reed is not reasonably pertinent to the problem with which the inventors were concerned because Reed does not acknowledge the nature of the problems of increasing user efficiency and/or flexibility in an electronic parcel compartment system. For this reason, Reed fails the second prong of the analogous art test.

Because Reed is neither in the field of the inventors' endeavor, nor reasonably pertinent to the problem with which the inventors were concerned, Reed

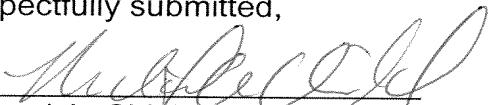
is non-analogous art to the instant claims. For this reason, the rejection of the instant claims in any part over Reed is improper and should be withdrawn.

**Conclusion**

For all the foregoing reasons, it is submitted that the application is of proper form and scope for allowance, and such action is solicited. Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance the application toward allowance, she is urged to telephone the undersigned at the indicated number.

April 1, 2009

Respectfully submitted,

By 

Michael A. Chinlund, Reg. No. 55,064  
MARSHALL, GERSTEIN & BORUN LLP  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Agent for Applicant